

U.S. Patent Appln. Ser. No. 10/618,249
Amendment and Response to Office Action dated January 3, 2006
March 6, 2006

REMARKS

Claims 1 and 35-59 are pending in this application. Claims 1 and 35 have been amended. No new matter has been added by way of these amendments. Support for these amendments can be found in the Specification as originally filed at least at p. 7, lines 17-22; p. 8, lines 4-6; p. 9, line 17 to p. 10, line 23; p. 11, lines 5-9 and lines 15-22; p. 12, lines 1-9; p. 13, lines 4-20; p. 15, lines 21-23; p. 16, line 18-13; p. 18, lines 13-15; p. 20; Fig. 1, elements 15, 20, 25; Fig. 2; Fig. 3A; Fig. 3B. Claims 39-42 have been amended for consistency with the remaining claims.

Claim 1 was rejected under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claim 1 of U.S. Patent No. 6,032,136 (the "'136 patent"). *See* Office Action at p. 2. Claims 1 and 35-59 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 6,014,645 to Cunningham ("Cunningham") in view of "VISA, MBNA and De La Rue Launch Multi-Function Smart Card Program," De La Rue Pic 7/06/1998 ("De La Rue"). *See* Office Action at pp. 3-11. Applicants traverse these rejections as set forth below.

I. Rejection Under Doctrine of Obviousness-Type Double Patenting.

Claim 1 was rejected under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claim 1 of U.S. Patent No. 6,032,136. *See* Office Action at p. 2. Claim 1 has been amended to add the further limitation that "information related to each feature is stored on the multi-value card in a machine-readable format, wherein the machine-readable format consists of a magnetic strip, an embossment, visible printing, RFID or any combination of a magnetic strip, an embossment, visible printing and RFID." Applicants respectfully submit that claim 1 as amended is patentably distinct over claim 1 of the '136 patent, and that this rejection should be withdrawn.

II. Rejections Under 35 U.S.C. § 103(a).

Claims 1 and 35-59 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 6,014,645 to Cunningham ("Cunningham") in view of "VISA, MBNA and De La Rue Launch Multi-Function Smart Card Program," De La Rue Pic 7/06/1998 ("De La Rue"). *See* Office Action at pp. 3-11.

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Claims 1 and 35 have been amended to add the further limitation that "information related to each feature is stored on the multi-value card in a machine-readable format, wherein the machine-readable format *consists of* a magnetic strip, an embossment, visible printing, RFID or any combination of a magnetic strip, an embossment, visible printing and RFID." (emphasis added). Applicants respectfully submit that neither Cunningham, nor De La Rue, alone or in combination, discloses this limitation of claims 1 and 35 and therefore these references do not support a *prima facie* case of obviousness.

De La Rue discloses a program that combines credit, stored value and loyalty functions on a single smart card, and compares its technology of a card having an embedded microchip to former technology including magnetic stripe cards. *See* De La Rue, first paragraph. De La Rue does not disclose a multi-value card that has at least one feature and optionally at least one secondary feature that are activated as claimed in independent claim 35, where information related to each feature is stored on the multi-value card in a machine-readable format, wherein the machine-readable format consists of a magnetic strip, an embossment, visible printing, RFID or any combination of a magnetic strip, an embossment, visible printing and RFID. Cunningham does not disclose a multi-value card at all.

Cunningham and De La Rue also do not provide any motivation for one to combine these references. In contrast, De La Rue teaches away from combining the magnetic-stripe card of Cunningham with its smart-chip based card. De La Rue notes that placement of "the functions of several traditional bankcards onto a single microchip" are accomplished by the "emerging technology" of the integrated circuit chip, which increases the "value of and demand for smart cards" due to these "value-added services" over traditional magnetic-stripe cards.

Since De La Rue and Cunningham do not disclose each and every limitation of claims 1 and 35, and specifically do not disclose that "information related to each feature is stored on the multi-value card in a machine-readable format, wherein the machine-readable format consists of a magnetic strip, an embossment, visible printing, RFID or any combination of a magnetic strip, an embossment, visible printing and RFID," Applicants respectfully submit that these references do not form a *prima facie* case of obviousness and that these rejections should be withdrawn. Since claims 36-59 are dependent from claim 35, the rejections under 35 U.S.C. § 103(a) over

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Cunningham and De La Rue should be withdrawn over these additional claims for the same reasons.

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CONCLUSION

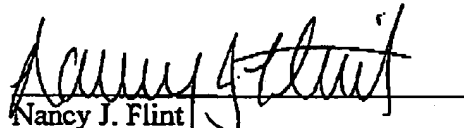
Claims 1 and 35-59 are believed to be in condition for allowance. This Amendment and Response has been filed within three months of the mailing date of the Office Action, and it is not believed that any fees are due in connection with this filing. However, if any fees are determined to be due, please charge the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

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